

REMARKS

This paper is in response to the Office Action mailed on February 24, 2005. In the Office Action, claims 1-62 were made subject to a genus-species restriction requirement. Reexamination and reconsideration of this case is respectfully requested in view of the following remarks.

No claim has been cancelled, added, or amended by this response. Claims 1-62 remain pending. Of those pending, claims 1, 10, 15, 20, 29-30, 39-41, 43, 50, and 53 are independent claims.

Applicant believes that no new matter has been added by this response

RESTRICTION REQUIREMENT

In section 1 of the Office Action, claims 1-62 were made subject to a genus-species type of restriction requirement under 35 USC 121. Applicant respectfully traverses in part.

In response to the restriction requirement, Applicant provisionally elects species II for prosecution on the merits and provides the following remarks.

On page 2 of the Office Action, it is stated that the claims are directed to two different species of inventions as follows:

Species I: Fig. 1, a first embodiment; and  
Species II: Fig. 4A, a second embodiment.

The Office Action alleges that there appears to be no generic claim. Applicant respectfully disagrees.

The Office Action did not explain the distinguishing features between Species I and Species II.

"Claims to be restricted to different species must be mutually exclusive. The general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. This is frequently expressed by saying that claims to be restricted to different species must recite the mutually exclusive characteristics of such species. "[MPEP § 806.04(f), 8<sup>th</sup> Edition, Rev. 2, May 2004, Pg. 800-41].

Applicant has compared the two species and reviewed claims 1-62 to offer the following comments:

Species I, Figure 1, is directed to the patterned roller 100A with its one or more rods 118 and the alignment holes 218,218' in the shims/rings 214,114 that is more fully illustrated by Applicant's Figures 1-3.

Species II, Figure 4A, is directed to the patterned roller 100B with its guide slot 418 and guide tabs 518 in the shims/rings 214',114' that is more fully illustrated by Applicant's Figures 4A, 5, and 6.

Claim 1-6 and 9-62 do not recite an element or limitation that distinguishes between the patterned roller 100A of Species I illustrated in Figure 1 and the patterned roller 100B illustrated in Figure 4A. That is in claims 1-6 and 9-62, Applicant cannot find claim limitations that are found in Species I and not Species II or claim limitations that are found in Species II and not Species I in order for them to be mutually exclusive under MPEP §806.04(f).

"[A] generic claim should read on each of these views." [MPEP § 806.04(d), 8<sup>th</sup> Edition, Rev. 2, May 2004, Pg. 800-41]. "[A] claim may include two or more of the disclosed embodiments within the breadth and scope of definition (and thus be designated a generic or genus claim)." [MPEP § 806.04(e), 8<sup>th</sup> Edition, Rev. 2, May 2004, Pg. 800-41]. That is, if claims read on both species in a genus-species restriction requirement, they are generic.

As it appears that claims 1-6 and 9-62 recite limitations that are not mutually exclusive and read on both Species I (Figure 1) and Species II (Figure 4A), Applicant respectfully submits that claims 1-6 and 9-62 are generic claims.

However, Applicant admits that dependent claims 7 and 8 are not generic.

Dependent claim 7, recites one or more rods and an opening in the one or more rings slidingly engaging the rods. Applicant's Figure 1 illustrates one or more rods 118 and rings 114. The one or more rings 114 have one or more alignment holes 218' to slidingly engage the one or more rods. (See also Applicant's Figures 2-3 for greater detail). However, Applicant's Figure 4A does not illustrate a patterned roller with one or more rings 114 having one or more alignment holes 218' to slidingly engage the one or more rods 118. Thus, the limitations found in dependent claim 7 are directed to Species I (Figure 1) only and not Species II (Figure 4A). Thus, claim 7 is not generic and is properly restricted to a species I claim only.

Dependent claim 8, recites a guide slot in the cylindrical sleeve and a guide tab in the one or more rings slidingly engaging the guide slot. Applicant's Figure 4A illustrates a

guide slot 418 and shims/rings 214', 114' with guide tabs 518 to engage the guide slot 418. (See also Applicant's Figures 5-6 for greater detail). However, Applicant's Figure 1 does not illustrate a patterned roller with a guide slot 418 and shims/rings 214', 114' with guide tabs 518 to engage the guide slot 418. Thus, the limitations found in dependent claim 8 are directed to Species II (Figure 4A) only and not Species I (Figure 1). Thus, claim 8 is not generic and is properly restricted to a species II claim only.

In summary, Applicant provides the following summarization as to how the claims read on Species I and II:

Claims 1-6, 7, and 9-62 read on Species I: Figs. 1-3,

Claims 1-6, 8, and 9-62 read on Species II: Figs. 4A, 5-6.

For the forgoing reasons, Applicant respectfully requests reconsideration of the restriction requirement under 37 CFR 1.143.

CONCLUSION

In view of the foregoing, reconsideration is respectfully requested.

The Examiner is invited to contact Applicant's undersigned counsel by telephone at (714) 557-3800 to expedite the prosecution of this case should there be any unresolved matters remaining.

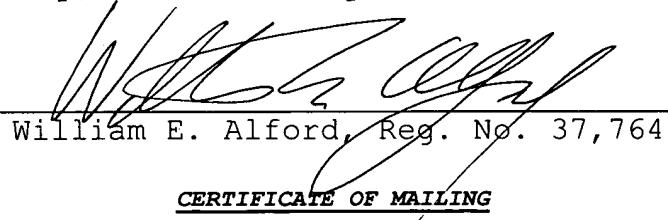
To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made.

Please charge any shortage in fees in connection with the filing of this paper, including extension of time fees, to Deposit Account 02-2666 and please credit any excess fees to such deposit account.

Respectfully submitted,

Blakely, Sokoloff, Taylor & Zafman LLP

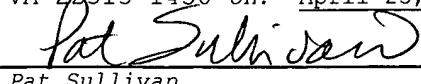
Dated: April 25, 2005

  
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450 on: April 25, 2005.

  
Pat Sullivan 4/25/05  
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